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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,570	08/16/2001	James Russell Hornsby	6881.01	4261

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EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 05/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/931,570	HORNSBY ET AL.
	Examiner Dmitry Suhol	Art Unit 3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4-13,16-21,23-38 and 40-43 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,4-13,16-21,23-38 and 40-43 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 12 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 of copending Application No. 10/071545. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 13-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/071545. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/966680. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11, 20, 32, 42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 11, 20, 32, 42, the phrase "data-reader writer writes data to the data storage device" was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There does not appear to be any support for the data reader-writer writing to a storage device in the specification. Although the examiner understands that these devices are well known in the art, the examiner is not clear on the "structure" which enables the "data-reader" to function in the disclosed and claimed invention. Please refer to the examiners response to arguments for more explanation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-11, 13, 17-20, 33, 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al in view of Mathieu et al. Lebensfeld discloses an interactive amusement device capable of a variety of scenarios and using a multiple of different accessories (col. 4, lines 56-62), containing most of the elements of the

claims including, a body as required by claims 1, 12-13, 21, 33, 43 (fig. 4, element 10), a transport element/limbs movably connected to a body as required by claims 1, 5, 10, 12-13, 19, 21, 31, 33, 41 (fig. 1, legs), a microprocessor as required by claims 1, 12-13, 23, 33, 43 (figure 6, element 60), a data reader-writer operably coupled to a microprocessor, as required by claims 1, 13, 23, 33, 43 is inherent since the device is made to upload and download upgrade data from/to a data storage device to enhance/add a function(s) of the device as required by claims 1, 11, 13, 20, 23, 26, 32-33, 36, 42-43 (fig. 5, element 49 and col. 9, lines 35-43), at least two arms moveably connected to a body as required by claims 21, 33, 43 (fig. 1, elements 47 and col. 7, lines 31-36).

Although Lebensfeld et al discloses most of the elements of the claims the reference fails to teach a motor associated with a body and coupled to a transport element as required by claims 1, 5, 13, 17, 23, 33, 43, a wireless receiver operably coupled to a microprocessor as required by claims 6, 13, 33, 43, a unit wireless transmitter associated with a body and coupled with a microprocessor as required by claims 8, 13, 33, 43, a remote wireless transmitter operably coupled with a wireless receiver as required by claims 7, 13, 33, 43, at least two wheels as required by claims 9, 18, 30, 40, 43. However, Mathieu discloses an interactive amusement device like that of Lebensfeld, which teaches a motor associated with a body and coupled to two transport elements (fig. 6, elements 42), a wireless receiver associated with a body (fig. 8, element 64), a unit wireless transmitter associated with a body and coupled with a microprocessor (figure 1, element 20), a remote wireless transmitter operably coupled

with a wireless receiver (figure 1, element 46) and at least two wheels (fig. 1, elements 38). Therefore it would have been obvious in view of Mathieu, to manufacture the device of Lebensfeld with the above mentioned features for the purpose of providing a remote controlled moving device that can simulate a "battle" scenario.

Claims 4, 12, 16, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al and Mathieu et al, in view of Li et al. Lebensfeld, as modified by Mathieu, discloses most of the elements of the claims, as stated above, and further including a means for powering the toy as required by claim 12 (col. 6, line 55). The reference fails to teach a data storage device being a card as required by claims 4, 12, 16, 38, enhancement data increasing the mobility of the device as required by claim 34, enhancement data increasing the speed of the device as required by claim 35, an additional function comprising a punching motion. However, Li discloses an interactive amusement device, which teaches the use of a data card and data card reader to upgrade certain functions of a device (fig. 20, col. 7, lines 50-64) such as mobility and speed. Therefore it would have been obvious, in view of Li, to use a card as a data device for the purpose of manufacturing the device of Lebensfeld, as modified by Mathieu, with easily upgradeable functions such as sound and movement, especially since Lebensfeld discloses a variety of scenarios and functions envisioned with his toy (col. 10, lines 44+). It would have been further obvious to make an additional function be a punching motion since Lebensfeld discloses a variety of scenarios and functions

envisioned with his toy (col. 10, lines 44+) and toy figures with punching features are well known in the art.

Claims 21, 23, 26, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al and Mathieu et al, as stated above, in view of Wilde, Suda or Carver et al. Lebensfeld, as modified by Mathieu, disclose most of the elements of the claims, as stated above, but for a motor operable coupled to at least two arms. However, Wilde, Suda and Carver all disclose a remote control interactive toy which teach a motor coupled to at least two arms (figure 1). Therefore it would have been obvious to couple the arms of Lebensfeld, as modified by Mathieu, to a motor to provide a more realistic toy and interest to the consumer.

Claims 24-25, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al, Mathieu et al, Wilde, Suda or Carver et al, as stated above, in view of Li et al. Lebensfeld, as modified by Mathieu, Wilde, Suda or Carver, discloses most of the elements of the claims, as stated above, but for a data storage device being a card as required by claims 28-29, enhancement data increasing the mobility of the device as required by claim 24, enhancement data increasing the speed of the device as required by claim 25, an additional function comprising a punching motion as required by claim 27. However, Li discloses an interactive amusement device, which teaches the use of a data card and data card reader to upgrade certain functions of a device (fig. 20, col. 7, lines 50-64) such as mobility and speed. Therefore it would have

been obvious, in view of Li, to use a card as a data device for the purpose of manufacturing the device of Lebensfeld, as modified by Mathieu, with easily upgradeable functions such as sound and movement, especially since Lebensfeld discloses a variety of scenarios and functions envisioned with his toy (col. 10, lines 44+). It would have been further obvious to make an additional function be a punching motion since Lebensfeld discloses a variety of scenarios and functions envisioned with his toy (col. 10, lines 44+) and toy figures with punching features are well known in the art.

### ***Response to Arguments***

Applicant's arguments filed 5 March 2003 have been fully considered but they are not persuasive. Applicants' argue that Lebensfeld et al fails to teach a data reader, a data storage device, that the user has the ability to modify the device (as opposed to a factory modification/preset) by using a data storage device or that the functionality of the device is modified by a user. The examiner disagrees and points out that Lebensfeld clearly teaches that his amusement device is intended to upload/download information via a (provided) computer (inherently contains a data-reader writer) to enhance the functions of the device (col. 9, lines 35-43). Regarding applicants' assertion that the device of Lebensfeld is intended to have preset or factory modifications rather than user modifications, the examiner points out that such modification (through the use of a computer and phone jack) to program each individual device produced would be cost prohibitive and not consistent with modern production techniques, therefore the

examiner's position is that Lebensfeld specifically intends for the user to upgrade the device. The examiner further points out that a storage device is encompassed by a computer and a floppy disk or hard drive.

Regarding applicants arguments with respect to the Li et al reference, the examiner points out that Li is relied upon to teach an interactive device responsive to data located on a data storage card (handled by a user), where the device functions (i.e. movement, mobility, and sound) are enhanced due to the data on the data card (see col. 7, lines 50-64 and figure 20) and since the device of Lebensfeld is concerned with downloading data to enhance the function of the device (i.e. sound, mobility) an artisan having ordinary skill in the art would have certainly looked to the teachings of Lebensfeld and Li at the time of the claimed invention.

Regarding applicants arguments with respect to rejections under 35 USC 112, first paragraph, the examiner agrees with the applicants that there are a variety of devices that can read and write data in a variety of formats (i.e. a home computer) however, upon careful examination of the applicants specification it is a mystery to the examiner why and how the applicants device would write to a card. The data reader-writer is not explained in any detail or generalities (does it use an optical, magnetic or electrical recording scheme?). Furthermore applicants disclose that the cards of their device are used to upgrade/enhance the functionality of their toys, but no mention is made of the toys providing any sort of feedback to the cards themselves, nor do the applicants disclose any play scenarios where such a step would be needed/required or

warranted. Therefore the examiner maintains his rejection as stated previously and in the current office action.

Regarding rejections under 35 USC 112, second paragraph with respect to claims 23-27 and 34-37 the examiner withdraws his rejections, but points out that the device of Lebensfeld, as modified by Mathieu, clearly discloses an upgradable (functionally) interactive toy with multiple play scenarios, where any of the enhanced functions recited in claims 23-27 and 34-37 are considered to be encompassed by the toy of Lebensfeld as modified.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

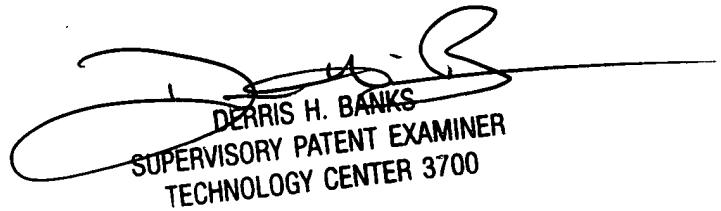
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds  
May 16, 2003



DERRIS H. BANKS  
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